

# PATENT COOPERATION TREATY

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From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

## PCT

WRITTEN OPINION  
(PCT Rule 66)

To:

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Date of mailing (day/month/year)	25.06.2004
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Applicant's or agent's file reference  
37960/GM/p

REPLY DUE	within 3 month(s) from the above date of mailing
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International application No.  
PCT/EP 03/08790

International filing date (day/month/year)  
07.08.2003

Priority date (day/month/year)  
19.09.2002

International Patent Classification (IPC) or both national classification and IPC  
E04B1/64

Applicant  
URETEK S.R.L. et al.

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
  - I ☒ Basis of the opinion
  - II ☐ Priority
  - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
  - IV ☐ Lack of unity of invention
  - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
  - VI ☐ Certain documents cited
  - VII ☐ Certain defects in the international application
  - VIII ☐ Certain observations on the international application
3. The applicant is hereby **invited to reply** to this opinion.
 

**When?** See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also:** For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.  
For an informal communication with the examiner, see Rule 66.6.

**If no reply is filed,** the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 19.01.2005

Name and mailing address of the international preliminary examining authority:



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**WRITTEN OPINION**

International application No. PCT/EP 03/08790

**I. Basis of the opinion**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

**Description, Pages**

1-16 as originally filed

**Claims, Numbers**

1-35 as originally filed

**Drawings, Sheets**

1/4-4/4 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims	
Inventive step (IS)	Claims	1-35
Industrial applicability (IA)	Claims	

**2. Citations and explanations****see separate sheet**

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following documents:

D1: DE 196 53 282 C

D2: US-B-6 309 493.

**5.1 Inventive step, independent claim 1.**

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 does not involve an inventive step in the sense of Article 33(3) PCT.

Document **D1**, regarded as being the closest prior art to the subject-matter of claim 1, discloses (the references in parentheses applying to this document):

- a method for waterproofing wall systems, consisting:
- in providing spaced injection holes (2) within a wall system (1) in a manner suitable to pass through cavities that exist in the wall system;
- in inserting injecting tubes (9) in said injecting holes;
- in injecting in said injection holes, through said injection tubes, a substance (claim 1, lines 53,54).

The subject-matter of claim 1 therefore differs from this known method in that:

A) the said substance expands after injection as a consequence of a chemical reaction.

The problem to be solved by the present invention may therefore be regarded as:

- to improve the extent of penetration of the substance into the cavities of the wall system.

The solution proposed in claim 1 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT), as feature A) is described in document D2 (claim 1, step d) as providing the same advantages as in the present application.

The skilled person would therefore regard it as a normal option to include this feature in the method described in document D1 in order to solve the problem posed.

## 5.2 Dependent Claims 2-35.

Dependent claims 2-35 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT with respect to novelty and inventive step (Article 33(2),(3) PCT), as said additional features are either also disclosed in the documents cited above with regard to the independent claims, or would be employed by the skilled person, if required, either on the basis of his expert knowledge alone or by way of combination with a disclosure from the cited state of the art.

## 6.0 Further Comments.

### 6.1 Clarity, claims.

Several dependent claims do not meet the requirements of Article 6 PCT, as the use of the expression "according to one or more of the preceding claims" (emphasis added) renders them unclear.

For example, claim 5 contradicts claim 4 and the extremely large number of possible combinations of features of each of the dependent claims is not supported by the description.

### 6.2 Prior Art.

To meet the requirements of Rule 5.1(a)(ii) PCT, documents D1 and D2 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

### 6.3 Suggestion.

When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims.

In particular it should be clear from the description:

- (a) which prior art document forms the basis for the two-part form of the claims
- (b) how the presently-claimed invention differs from this closest prior art
- (c) what technical advantage this distinction brings.

Care should be taken during revision, especially of the introductory portion and any statements of problem or advantage, not to add subject-matter which extends beyond the content of the application as originally filed (Article 34(2)(b) PCT).

In order to facilitate the examination of the conformity of the amended application with the requirements of Article 34(2)(b) PCT, the applicant shall, as required by Rule 66.8(a) PCT, draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

The applicant is requested to file amendments by way of replacement pages in the manner stipulated by Rule 66.8(a) PCT. In particular, fair copies of the amendments should be filed, preferably in triplicate.

Moreover, the applicant's attention is drawn to the fact that, as a consequence of Rule 66.8(a) PCT the examiner is not permitted to carry out any amendments under the PCT procedure, however minor these may be.